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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/579,995   | 05/21/2007  | Claire F. Jessup     | 900158.401USPC      | 8939             |
| 500 7590 09/16/2009<br>SEED INTELLECTUAL PROPERTY LAW GROUP PLLC<br>701 FIFTH AVE<br>SUITE 5400<br>SEATTLE, WA 98104 |             |                      |                     |                  |
| EXAMINER<br>WEHBE, ANNE MARIE SABRINA  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1633   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/579,995

**Applicant(s)**

JESSUP ET AL.

**Examiner**

Anne Marie S. Wehbe

**Art Unit**

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Applicant's preliminary amendment filed on 5/19/06 canceled claims 2-72. Claim 1 is currently pending in the instant application. An action on the merits follows.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Oral et al. (1997) Gene Therapy, Vol. 4, 639-647. The applicant claims a method of modifying cells of ocular tissue to produce an immunoglobulin or fragment thereof comprising transfecting ocular tissue with an expression vector comprising a nucleotide sequence encoding for the immunoglobulin or immunoglobulin fragment, such that cells of said ocular tissue produce the immunoglobulin or immunoglobulin fragment. Note that the claims as written encompass both the transfection of ocular cell/tissues *ex vivo* and *in vivo*.

Oral et al. teaches transfecting excised donor corneas with a recombinant adenoviral vector encoding a chimeric protein comprising CTLA-4 and a fragment of a human Ig molecule where the transfected corneal tissue expressed the chimeric protein comprising the Ig fragment (Oral et al., pages 640, and 643, Figure 5). Thus, by teaching all the limitations of the claims as written, Oral et al. anticipates the instant invention as claimed.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Comer et al. (2002) IOVS, Vol. 43(4), 1095-1103. The applicant claims a method of modifying cells of ocular tissue to produce an immunoglobulin or fragment thereof comprising transfecting ocular tissue with an expression vector comprising a nucleotide sequence encoding for the immunoglobulin or immunoglobulin fragment, such that cells of said ocular tissue produce the immunoglobulin or immunoglobulin fragment. Note that the claims as written encompass both the transfection of ocular cell/tissues *ex vivo* and *in vivo*.

Comer et al. teaches transfecting excised donor corneas with a recombinant adenoviral vector encoding a chimeric protein comprising CTLA-4 and a fragment of a human Ig molecule where the transfected corneal tissue expressed the chimeric protein comprising the Ig fragment (Comer et al., pages 1098-1099, Figure 5). Thus, by teaching all the limitations of the claims as written, Comer et al. anticipates the instant invention as claimed.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication 2005/0220768 (2005), hereafter referred to as McVey et al. The applicant claims a method of modifying cells of ocular tissue to produce an immunoglobulin or

fragment thereof comprising transfecting ocular tissue with an expression vector comprising a nucleotide sequence encoding for the immunoglobulin or immunoglobulin fragment, such that cells of said ocular tissue produce the immunoglobulin or immunoglobulin fragment. Note that the claims as written encompass both the transfection of ocular cell/tissues *ex vivo* and *in vivo*.

McVey et al. teaches the administration of expression vectors encoding an anti-angiogenic factor to the eye for the transfection of ocular cells and expression of the encoded factor (McVey et al., pages 2-3, 8, and 11). McVey et al. further teaches that the anti-angiogenic factor is an antibody which binds to an angiogenic factor (McVey et al., page 11, particularly paragraph 71). McVey et al. also teaches various routes for contacting ocular cells *in vivo* with expression vectors including intraocular administration (McVey et al., page 14, paragraph 89). Thus, by teaching all the limitations of the claims as written, McVey et al. anticipates the instant invention as claimed.

No claims are allowed.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. If the examiner is not available, the examiner's supervisor, Joseph Woitach, can be reached at (571) 272-0739. For all official communications, the technology center fax number is (571) 273-8300. Please note that all official communications and responses sent by fax must be directed to the technology center fax number. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737. For any inquiry of a general nature, please call (571) 272-0547.

The applicant can also consult the USPTO's Patent Application Information Retrieval system (PAIR) on the internet for patent application status and history information, and for electronic images of applications. For questions or problems related to PAIR, please call the USPTO Patent Electronic Business Center (Patent EBC) toll free at 1-866-217-9197. Representatives are available daily from 6am to midnight (EST). When calling please have your application serial number or patent number available. For all other customer support, please call the USPTO call center (UCC) at 1-800-786-9199.

Dr. A.M.S. Wehbé

*/Anne Marie S. Wehbé/*  
Primary Examiner, A.U. 1633